ELECTION

During a telephone conversation with Examiner Michael P. Colaiann on May 3, 2006, a provisional election was made without traverse to elect Group II. Applicant affirms the election of Group II, which includes claims 16-20.

REMARKS

Claims 16 to 20 are pending. Claims 1-15 and 21-23 have been withdrawn from consideration. Claims 16, 17, 18, and 19 are amended by this paper.

Double Patenting

Claim 16 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 10/806,957.

Applicant requests this rejection be held in abeyance until allowable subject matter is indicated.

§ 112 Rejections

Claims 17 and 18 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant thanks the Examiner for suggesting correction of claims 17 and 18, which have been amended as suggested.

In summary, Applicant submits that the rejection of claims 17 and 18 under 35 USC § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 102 Rejections

The Brandes Reference

Claims 16, 17, and 19 stand rejected under 35 USC § 102(b) as being anticipated by Brandes (US Patent 4,190,245; issued February 26, 1980).

Claim 16 has been amended to recite creating a signal based on the position of the radiused section or the measured radius of the radiused section, either singly or in a combination thereof; and controlling the effective radius based on the signal while the web is moving through the web path. Applicant submits that amended claim 16 is not taught or suggested by Brandes.

First, Brandes is not directed to a web, but to a system for handling a sheet. Brandes does not properly teach or suggest a method directed to a web. Second, Brandes lacks any proper teaching or suggestion of creating any signal based on the position of the radiused section or the measured radius of the radiused section, either singly or in a combination thereof. There is simply no need to create any signal because the sheet handling system of Brandes does not require one to accomplish its intended purpose. Also, Brandes does not control the effective radius based on any signal, nor is it needed by Brandes to accomplish its intended purpose. In sum, Brandes is an open loop system and needs no signal to control the radiused section of the sheet.

Claims 17 and 19 depend from and further limit claim 16.

For at least the foregoing reasons, the rejection of claims 16, 17 and 19 under 35 USC § 102(b) as being anticipated by Brandes (US Patent 4,190,245) has been overcome and withdrawal of the rejection is respectfully requested.

The Okubo Reference

Claims 16, 17, and 19 stand rejected under 35 USC § 102(b) as being anticipated by Okubo et al (JP Abstract 63171755; published July 15, 1988).

Applicants have submitted an unverified translation of the Okubo reference as a courtesy to the Examiner. It is with reference to the translated version that Applicants directs the following comments.

First, the portion of the Okubo reference relied on by the Examiner relies on is directed to a sheet handling mechanism. A web is cut at the autocutter **6** (as illustrated in Figure 1) to form a sheet (Okubo p.4) which is then transported through rolls **7, 8, 9, 10**. The backing rolls **9, 10** form a nip that grabs the sheet and moves it through the rollers.

Amended claim 16 recites that the web is passed through the web path in the absence of contact on one side of the web. Examples of this no contact condition can be seen in Figures 1A

and 2A of the instant application. Okubo lacks any proper teaching or suggestion of this no contact condition, and would not function for its intended purpose in the absence of the nip rollers **9, 10**.

In addition, Okubo is silent on having any teaching or suggestion of creating a signal based on the position of the radiused section or the measured radius of the radiused section, either singly or in a combination thereof; and controlling the effective radius based on the signal while the web is moving through the web path, which is recited by amended claim 16. The only sensor referenced in Okubo is sensor **12**, which detects the presence of a sheet leading edge (Okubo p. 5).

Claims 17 and 19 depend from and further limit claim 16.

For at least the foregoing reasons, the rejection of claims 16, 17 and 19 under 35 USC § 102(b) as being anticipated by Okubo has been overcome and withdrawal of the rejection is respectfully requested.

The Mogensen Reference

Claims 16, 18, and 19 stand rejected under 35 USC § 102(b) as being anticipated by Mogensen (WO 98/56702; published December 17, 1998).

The claims stand rejected on the basis that "[a] plastic strain is inherently introduced in the web when the web passes through the second portion over the transverse fold line/baffle" of Mogensen. (page 7 of Office Action).

It is Applicant's position that the rejection of claims 16, 18, and 19, as given, is not a proper 102(b) rejection because the inherency contention is not supported by sufficient evidence in the Mogensen specification.

As a preliminary matter, for a fact to be inherent in a reference, the Examiner must provide rationale or evidence tending to show inherency. MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that characteristic or result. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described (in the reference) and that it would be so recognized by persons of ordinary skill. Inherency however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Roberts, 169 F3d 43, 45 (Federal

Circuit 1999). Applicant submits that it is not clear in the Mogensen reference to establish that a plastic strain is necessarily introduced and that the statement regarding inherency in the Office Action offers a conclusion without further support.

"In relying upon theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Board Of Patent Appeals And Interferences 1990). It is Applicant's position that the rejection as given in the Office Action does not provide a basis in fact or technical reasoning to reasonably support the assertion that the allegedly inherent characteristic (introduction of a plastic strain) necessarily flows from the teaching of the Mogensen reference.

Contrary to the claim of inherency, Applicant submits that Mogensen teaches that the material described (mineral fiber; p. 5, ln. 33-35) for use in the system is of a type for which it is undesirable to strain, since such strain can cause web debonding or pieces to break off the web. In fact, the problem solved by Mogensen is avoiding the use of a fixed edge in turning the web (p. 2, ln. 35 to p.3, ln. 2), which further supports the lack of inherency of straining the mineral fiber webs of Mogensen.

Because the rejection, as made, does not provide a basis in fact and/or technical reasoning to reasonably support the determination that the web of Mogensen is plastically strained, as required by claims 16, 18, and 19, it cannot be said that this characteristic necessarily flows from the Mogensen reference.

In addition, Mogensen is silent on having any teaching or suggestion of creating a signal based on the position of the radiused section or the measured radius of the radiused section, either singly or in a combination thereof; and controlling the effective radius based on the signal while the web is moving through the web path, which is recited by amended claim 16.

Claims 18 and 19 depend from and further limit claim 16.

For at least the foregoing reasons, the rejection of claims 16, 18 and 19 under 35 USC § 102(b) as being anticipated by Mogensen has been overcome and withdrawal of the rejection is respectfully requested.

§ 103 Rejections

The Brandes Reference

Claims 18 and 20 stand rejected under 35 USC § 103(a) as being unpatentable over Brandes (US Patent 4,190,245; issued February 26, 1980).

Claims 18 and 20 ultimately depend from claim 16, which is patentable over Brandes for the reasons given above. Claims 18 and 20 each added additional features to claim 16. As such, they are likewise patentable over Brandes.

The rejection of claims 18 and 20 under 35 USC § 103(a) as being unpatentable over Brandes (US Patent 4,190,245; issued February 26, 1980) has been overcome and withdrawal is respectfully requested.

The Okubo Reference

Claims 20 stands rejected under 35 USC § 103(a) as being unpatentable over Okubo et al (JP Abstract 63171755; published July 15, 1988).

Claims 20 ultimately depends from claim 16, which is patentable over Okubo for the reasons given above. Claims 20 adds additional features to claim 16. As such, claim 20 is likewise patentable over Brandes

The rejection of claim 20 under 35 USC § 103(a) as being unpatentable over Okubo et al (JP Abstract 63171755; published July 15, 1988) has been overcome and withdrawal is respectfully requested.

Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of amended claims 16-20, as amended, at an early date is solicited. If a telephone interview would be helpful in resolving any issues, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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Date

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